

REMARKS

Claims 1-82 are pending in this application. Claims 1-48, 50-59, 61-73 and 75-82 have been allowed without the necessity of amendment. No claim has been amended herein, since all claims as pending in this application, including rejected claims 49, 60 and 74 are believed to be distinguishable over cited prior art of record and should be deemed in condition for allowance.

Claims 49, 60 and 74 have been rejected under 35 U.S.C. §102(e) as being anticipated by newly cited art, Arai et al., U.S. Patent No. 6,411,587 for reasons stated on pages 2-4 of the Office Action (Paper No. 20050204). However, Therefore, Applicants respectfully traverse the rejection and request the Examiner to withdraw the rejection for the following reasons.

First of all, Arai et al., U.S. Patent No. 6,411,587 does not qualify as prior art against Applicants' claims 49, 60 and 74 as pending in this application. This is because Applicants' foreign priority date of October 30, 1999 predates the U.S. filing date (October 5, 2000) of Arai '587. Applicants' claim of foreign priority date under 35 USC §119 and 37 CFR §1.55 was perfected on October 30, 2000, when certified copies of prior foreign application documents, i.e., Korean Patent Application Nos. 99-47747 and 99-47751, were filed in USPTO on October 30, 2000.

Secondly, even assuming *arguendo* that Arai '587 qualifies as prior art against Applicants' claims 49, 60 and 74, which Applicants do not believe, claims 49, 60 and 74 are still deemed distinguishable over Arai '587, partly because Arai '587 does not disclose any light source to emit respective light beams of different wavelengths, i.e., a first light beam with a wavelength within a range of wavelengths under 500 nm and ... for use with recording and/or reproducing with respect to a first medium, and a second light beam with a wavelength outside of the range ... for use with recording and/or reproducing with respect to a second medium, and partly because Arai '587 does not disclose any collimating lens having a diverging power to enable focusing of the first light beam onto the first medium and the second light beam onto the second medium, respectively, with negligible aberration, as generally defined in Applicants' base claims 49, 60 and 74.

For example, on page 2 of the Office Action (Paper No. 20050204), the Examiner cites FIG. 21, column 17, lines 12-15; column 20, lines 47-56; structures 50 and 61 of Arai '587 for allegedly disclosing "a light source 111 to generate a first light beam with a wavelength within a

wavelength range of wavelength under 500 nm and which includes 400 nm for use with recording and/or reproducing with respect to a first medium" and "a second light beam with a wavelength outside of the range (400 nm) and which is roughly 650 nm for use with recording and/or reproducing with respect to a second medium other than the first medium." The Examiner further asserts that the blue laser has a wavelength range under 500 nm, and the red laser has a wavelength range roughly about 650 nm.

However, the Examiner's citation is misplaced. Moreover, the Examiner's assertion is also factually incorrect. Arai '587 discloses two basic embodiments of an optical pickup system, as shown, for example, in FIG. 1 and FIG. 21. In FIG. 21, only a single light source 11 is utilized to emit a light beam having a wavelength of about 400 nm. Alternatively, in FIG. 21, two different light sources 111, 112 are utilized to emit a 1st light beam having a wavelength of 635 nm or 650 nm, as described on column 45, lines 27-29, and a 2nd light beam having a wavelength of 780 nm, as described on column 45, lines 60-62. However, these two embodiments are not interchangeable. As a result, the Examiner cannot arbitrarily select one light beam emitted from a single light source in one embodiment (FIG. 1) and combine the same light beam with another light beam emitted from multiple light sources in another embodiment (FIG. 21) for purposes of supporting an anticipation rejection under 35 USC §102(e).

The cited column 17, lines 12-15; column 20, lines 47-56; structures 50 and 61 of Arai '587 only refer to the use of a blue laser light source and a read laser light source for emitting a 1st light beam having a wavelength of 635 nm or 650 nm, and a 2nd light beam having a wavelength of 780 nm. There is **no** disclosure anywhere in Arai '587 of Applicants' claimed "light source to generate a first light beam with a wavelength within a wavelength range of wavelength under 500 nm and which includes 400 nm for use with recording and/or reproducing with respect to a first medium and a second light beam with a wavelength outside of the range (400 nm) and which is roughly 650 nm for use with recording and/or reproducing with respect to a second medium other than the first medium" as expressly defined, for example, in base claim 49.

Similarly, on page 3 of the Office Action (Paper No. 20050204), the Examiner cites FIG. 11 and FIG. 25 of Arai '587 for allegedly disclosing "the diverging power of the diverging lens 113 is sufficient to allow the optical element 115 be capable of focusing the first light beam for each of the wavelengths within the range (450 nm) onto the first medium with negligible aberration" and "the diverging power of the diverging lens 113 is sufficient to allow the optical element 115

be capable of focusing the second light beam with the wavelength of roughly 650 nm onto the second medium with negligible aberration."

Again, the Examiner's citation is misplaced. There is no FIG. 25 anywhere in Arai '587. Moreover, the cited FIG. 11 simply illustrates an optical path diagram of an optical pickup optical system, between a collimator 113 and an optical element. Again, there is no disclosure anywhere in Arai '587 of Applicants' claimed "diverging power of the diverging lens ... focusing the first light beam ... the second light beam" as expressly defined, for example, in base claims 49, 60 and 74.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, even assuming *arguendo* that Arai '587 qualifies as prior art against Applicants' claims 49, 60 and 74, Arai '587 still fails to disclose and suggest key features Applicants' claims 49, 60 and 74. Therefore, Applicants respectfully request that the rejection of claims 49, 60 and 74 be withdrawn.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should

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any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505.

Lastly, if necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage of fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account of Stein, McEwen & Bui, LLP, No. 503333, and credit any excess fees to said deposit account.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

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By: Hung H. Bui
Hung H. Bui
Registration No. 40,415

1400 Eye St., NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510